

### **REMARKS**

In response to the Office Action mailed May 28, 2009, the Applicants sincerely request reconsideration in view of the above claim amendments and the following remarks. Claims 1, 17, and 26 have been amended for clarification and claims 7, 11, and 22 have been canceled without prejudice or disclaimer. Support for the amendments may be found in at least the aforementioned cancelled claims. No new matter has been added.

#### ***Statement of Common Ownership***

The present patent application (Serial No. 10/692,200) and U.S. Published Patent Application 2004/0100480 (Lupu) were, at the time the claimed invention in the present patent application was made, owned by, or subject to an obligation of assignment to, Microsoft Corporation of Redmond, Washington.

#### ***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 1-4, 7-10, 12-18, 20-21, 23-24, 26-29, and 32-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Breinberg et al., U.S. Patent No. 5,886,694, (hereinafter *Breinberg*) in view of Buxton et al. (US 6,469,714, hereinafter “Buxton”). Claim 7 has been canceled without prejudice or disclaimer rendering the rejection of this claim moot. The rejection of the remaining claims is respectfully traversed.

It is respectfully submitted that the combination of *Breinberg* and *Buxton* fails to teach, disclose, or suggest each of the features specified by claims 1-4, 8-10, 12-18, 20-21, 26-29, and 32-33. Amended Claim 1 recites a method of making ready for presentation a graphical element in a computer application program by communicating with a computer operating system comprising, *inter alia*, signaling the element's need to be measured by the first procedure, wherein the signaling comprises notifying the element's parent-element.

As conceded in the Office Action, the combination of *Breinberg* and *Buxton* fails to teach a signaling step which comprises notifying the element's parent-element. (See Office Action, page 19, paragraph 5). It is noted that in the Office Action, Lupu (US 2004/0100480, hereinafter *Lupu*), is relied upon for allegedly teaching the aforementioned feature. However, the Applicants respectfully submit that *Lupu* is disqualified as prior art under 35 U.S.C. § 103(c)(1).

Pursuant to 35 U.S.C. § 103(c)(1), "Subject matter developed by another person, which qualifies as prior art under only one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

*Lupu*, which was filed on November 21, 2003 and published on May 27, 2004, is subject to an obligation of assignment to Microsoft Corporation of Redmond Washington. Since *Lupu* was published after the filing date of the present patent application, it qualifies as prior art under only one or more subsections (e), (f), and (g) of 35 U.S.C. § 102(e). Applicants' Statement of Common Ownership, *supra*, establishes that *Lupu* and the claims in the present patent application were owned by or subject to an obligation of assignment to Microsoft Corporation at the time the claimed invention in the present patent application was made.

Thus, *Lupu* is disqualified as prior art under 35 U.S.C. § 103(c)(1) and since the combination of *Breinberg and Buxton*, standing alone, fails to teach, disclose, or suggest all of the features specified in amended claim 1, this claim is allowable and the rejection of this claim should be withdrawn. Claims 2-6, 8-10, and 12-16 depend from claim 1, and are thus allowable for at least the same reasons.

Amended independent claim 17 specifies "wherein the first procedure is used for signaling to the parent element a child element's need to be measured" which was previously recited in now canceled claim 22. As conceded in the Office Action, the combination of *Breinberg and Buxton* fails to teach a procedure for signaling to a parent element the child element's need to be measured. (See Office Action, page 20, continuation of paragraph 5 from page 19). As discussed above, *Lupu*, relied upon in the Office Action for allegedly teaching this feature, is disqualified as prior art under 35 U.S.C. § 103(c)(1). Therefore, amended claim 17 is allowable and the rejection of this claim should be withdrawn. Amended independent claim 26 specifies similar features as claim 17 and thus is also allowable for at least the same reasons. Claims 18, 20-21, 23-24, 27-29, and 32-33 depend from claims 17 and 26, and are thus allowable for at least the same reasons. Accordingly, the rejection of these claims should also be withdrawn.

***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 11 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Breinberg* in view of *Buxton* in further view of *Lupu* (“*Lupu*”, U.S. Publication 2004/0100480). Claims 11 and 22 have been canceled without prejudice or disclaimer rendering the rejection of these claims moot.

**CONCLUSION**

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.

Date: August 14, 2009

/Alton Hornsby III/

Alton Hornsby III

Reg. No. 47,299

P.O. Box 2903  
Minneapolis, MN 55402-0903  
404.954.5064

**27488**

PATENT TRADEMARK OFFICE